

Application No. 09/463,681
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REMARKS/ARGUMENTS

The Applicants respectfully request consideration of the following remarks in response to the communication of April 30, 2003.

Claims 1-11, 13, 14 and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over JP 02300281A ("JP '281") in view of Soltwedel. The Applicants respectfully traverse this rejection for at least the following reasons.

In order to establish a *prima facie* case of obviousness, the Examiner must demonstrate: 1) a suggestion to combine or modify the cited references to obtain the claimed invention; 2) a reasonable expectation of a successful combination of the references; and 3) that the cited art teaches all claim limitations of the pending application.¹ The Applicants submit that the Examiner has failed to establish a *prima facie* case of obviousness because none of these three elements have been demonstrated by the proposed combination of JP '281 with Soltwedel.

JP '281A discusses "[a] method for temp.[orarily] protecting the coated surfaces of new finished cars" which is used "instead of conventional wax coating[s]".² There is no disclosure or suggestion of a laminar coating wherein a thermoplastic film, either alone or in conjunction with a second coating layer, determines the decorative effect of a laminar coating. Admitting that JP '281A does not describe "the recited steps of applying and electrophoretically depositing",³ the Examiner attempts to remedy this inadequacy by citing Soltwedel which allegedly recites the omitted process steps to produce a surface which "then may be coated with decorative topcoats."⁴ The motivation to combine these references, it is argued, is "suggested by SOLTWEDEL because the selection of any of known equivalent vehicles' exterior finish would be within the level of ordinary skill in the art."⁵

Even if, *in arguendo*, JP '281A and Soltwedel were combined the combination would not result in a process or product in which a thermoplastic film, either alone or in combination with a second coating layer, determines a decorative effect of the laminar

¹ See: MPEP §2143.

² See West Abstract of JP '281A

³ Paper No. 26, page 5.

⁴ Paper No. 26, page 6.

⁵ Paper No. 26, page 6.

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coating. The Examiner provides no reason why the skilled artisan would expect that applying a substance designed to replace shipping wax would look even remotely "decorative". Nor would it be reasonable to assume that a skilled artisan would expect such temporary coatings would produce the claimed decorative effect. Therefore, there is neither a suggestion to combine these references nor a reasonable expectation of successfully obtaining the presently claimed invention even if the disclosures of these references could be combined. Accordingly, the Applicants request withdrawal of this rejection.

Claims 1-12 and 14-19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over WO 90/01051 ("WO '051) in view of Soltwedel *et al.* (US 5,624,978). The Applicants respectfully traverse this rejection for at least the following reasons.

The presently claimed invention bonds a thermoplastic film directly on the second coating layer by using an adhesive to form a third coating layer of the protective and decorative laminar coating. Again admitting that the primary reference (WO '051) fails to recite the "steps of applying and electrophoretically depositing",⁶ the Examiner cites Soltwedel for the same reasons as above – but fails to explain where in either of these references the recited bonding is performed with the use of an adhesive. Since all of the claimed elements have not been taught by the cited references, the Applicants respectfully request reconsideration and withdrawal of this rejection.

Finally, claims 1-12, 14, 15, 17 and 19 stand rejected under 35 U.S.C. §103(a) as obvious over Sadler *et al.* (US 4,626,559), in view of Soltwedel. The Applicants traverse this rejection for at least the following reasons.

Sadler, noting that "[a]thletic sponsors and boosters frequently decorate their cars...with paint or shoe polish" which "injures the paint through discoloration or dying", provides "a non-permanent ornamental paint mixture that is water soluble after drying."⁷ As above, Soltwedel is combined to provide the process steps of applying and electrophoretically depositing the prior laminar layers.

While high school students around the country were no doubt appreciative of Sadler's invention because it allowed them to paint refrains such as "GO TIGERS" on their parent's cars with impunity, they were hardly doing so by using an adhesive to bond a thermoplastic

⁶ Paper No. 26 page 3.

⁷ US 4,626,559 at Col. 1, lines 5-21.

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film to these cars. As was the case with WO '051, the Examiner fails to demonstrate how a reference which is silent as to bonding a thermoplastic film with an adhesive could render the presently claimed invention obvious. Again, because not all of the claim limitations are taught by the prior art, the Applicants respectfully request reconsideration and withdrawal of this rejection.

Therefore, all objections and rejections having been addressed, it is respectfully submitted that the present application is in a condition for allowance and a Notice to that effect is earnestly solicited.

Should any issues remain unresolved, the Examiner is encouraged to contact the undersigned attorney for Applicants at the telephone number indicated below in order to expeditiously resolve any remaining issues.

Respectfully submitted,

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